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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/756,257 11/25/96 SCHELLENBERG

J PII3248

QM12/0911

EXAMINER

PICKER INTERNATIONAL INC
595 MINER ROAD
HIGHLAND HEIGHTS OH 44143

CASLER, B

ART UNIT

PAPER NUMBER

3737

23

DATE MAILED:

09/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/756,257	Applicant(s) SCHELLENBERG, JOHN D.
Examiner Brian L Casler	Art Unit 3737	
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		
Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>20 June 2001</u> .		
2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.		
Disposition of Claims		
4) <input checked="" type="checkbox"/> Claim(s) <u>1,6-13,15,22,26,29,31 and 36-40</u> is/are pending in the application.		
4a) Of the above claim(s) _____ is/are withdrawn from consideration.		
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.		
6) <input checked="" type="checkbox"/> Claim(s) <u>36-40</u> is/are rejected.		
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.		
8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.		
Application Papers		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner.		
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner.		
If approved, corrected drawings are required in reply to this Office action.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
Priority under 35 U.S.C. §§ 119 and 120		
13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).		
a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of:		
1. <input type="checkbox"/> Certified copies of the priority documents have been received.		
2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.		
3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).		
* See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).		
a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.		
15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
Attachment(s)		
1) <input type="checkbox"/> Notice of References Cited (PTO-892)		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.		
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
6) <input type="checkbox"/> Other: _____.		

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 36,37, and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Shapiro et al(5645065).

Shapiro et al(5645065) teaches a catheter position and orientation system that includes a display located on the tool for indicating position, orientation, and depth. An indication of current position, orientation, and depth will give the surgeon using the device a reference with respect to a desired position and direction of movement.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 36,37,39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manwaring et al. In view of Yabe.

Manwaring et al. teaches everything including a method and apparatus for guiding an instrument to a target within the body. Manwaring et al. teaches guiding a probe such as an endoscope along a selected trajectory to the target.

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The system in Manwaring et al. Includes a display for indicating the orientation and position of the probe, the desired position with respect to the selected trajectory, and a direction in which the probe should be moved to return to the selected trajectory. The system includes the use of a number of known types of sensors to detect the position and orientation of the probe such as infrared, acoustic, or mechanical.

The probe also includes the ability to take live forward-looking video images from the tip of the probe which may be included in the display. It is also important in Manwaring et al. that the display be located so that its visually presented information is conveniently viewed by the surgeon. Please note col. 3, lines 24-36, col. 4, lines 1-67, col. 6, lines 23-35, cols. 7-8, lines 64-67 and 1-9 respectively as well as figs. 1-2.

Manwaring et al. does not teach a display means mounted to the probe.

Yabe teaches an endoscope system for getting biopsy information in which the endoscope includes a monitor for displaying live video images from the tip of the endoscope. Note col. 2, lines 22-68 and fig. 1.

In view of Yabe, it is well known to include on an endoscope itself a monitor to display live video images of the inside of the body wherein the images are conveniently viewable by a surgeon during a procedure. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the endoscope of Yabe with the system of Manwaring et al. to allow the information regarding the position, orientation, and trajectory of the endoscope be displayed on the endoscope itself where it may be conveniently viewed by the surgeon while guiding the endoscope along the selected trajectory.

Allowable Subject Matter

Claims 1,6-13,15,22,26, 29, and 31 are allowed.

Response to Arguments

3. Applicant's arguments with respect to claims 36-40 have been considered but are moot in view of the new ground(s) of rejection.

Regarding Manwaring et al and Yabe, applicant argues there is no reasoning provided to modify Manwaring et al. in view of Yabe and suggests the use of hindsight reasoning by the examiner.

"It should be too well settled now to require citation or discussion that the test for combining references is not what the individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

Manwaring et al. is directed to guiding a surgical instrument to a target within a body part and includes an endoscope as one particularly desirable surgical instrument.(Note col. 3, lines 1-37). Manwaring et al. also teaches displaying live video images with the trajectory information on **one display and the desirability of locating the display so that it's visually presented information may be conveniently viewed by the surgeon during surgery.**(Note col. 4, lines 4-10, fig. 2 and col. 4, lines 45-68 and col. 5, lines 1-35).

Yabe teaches an endoscope having a solid state imager and a display mounted onto the endoscope for displaying the video images during a surgical procedure such as a biopsy. The Yabe reference is only being used as a possible endoscope for the endoscope used in the Manwaring et al. system.

It is the examiner assertion that one of ordinary skill in the art would recognize, in view of the teachings of Manwaring et al. regarding displaying live video images and CT slices with the trajectory information on one display and **the desirability of locating the display so that it's visually presented information may be conveniently viewed by the surgeon during surgery**, the display mounted on the endoscope, as in Yabe, clearly achieves the purpose of **locating the display so that it's visually presented information including live video images, CT slices and trajectory information may be conveniently viewed by the surgeon during surgery as taught by Manwaring et al.**

The motivation and reasoning by the examiner comes only from teachings in the references and the general knowledge of one of ordinary skill in the art and does not rise to the level of hindsight reasoning.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian L Casler whose telephone number is 703-308-3552. The examiner can normally be reached on days M - Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on 703-308-3256. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0758 for regular communications and 703-308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Brian L Casler
Primary Examiner
Art Unit 3737

BLC
September 10, 2001